

Attorney Docket Number: FSP0357

Application Number: 10/578,872

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## REMARKS

These remarks are responsive to the Office action dated August 4, 2008. Claims 1-16 are pending in the application. Claim 1 has been amended. Support for the amendment to claim 1 may be found in paragraphs 0047-0049. Applicants respectfully request reconsideration of the application and allowance of the pending claims. Applicants thank the Examiner for his examination of the application. In the office action:

2. **Claim 1** is rejected under 35 U.S.C. 102 (b) as being anticipated by US Patent 5,721,829 to Dun et al (hereafter referenced as Dunn).
3. **Claim 2** is rejected under 35 U.S.C. 102 (b) as being anticipated by US Patent 6,115,057 to Kwoh et al (hereafter referenced as Kwoh).
5. **Claims 3-8 and 10-15** are rejected under 35 U.S.C. 102 (e) as being anticipated by US PG Pub 2003/0188316 to DePrez et al (hereafter referenced as DePrez).
7. **Claims 9 and 16** are rejected under 35 U.S.C. 103 (a) as being unpatentable over DePrez et al in view of Kwoh et al.

### Rejection of Claim 1 RE: 35 U.S.C. §102(b)

Claim 1 has been rejected under 35 U.S.C. §102(b) as being anticipated by Dunn *et al.* (U.S. Patent No. 5,721,829). Applicants respectfully traverse this rejection.

Claim 1, as amended, requires that the set top box send a marker obtained from the stream for an audio and/or video stream for which the set top box has paused or suspended viewing. In Dunn *et al.*, the set top box SQL database maintains a pause/resume register which contains the program ID of the paused program, the viewer ID of the STB that sent the pause message, and the pause point at which the program is stopped. (Dunn, *et al.*, col. 6, lines 56-60). There is no reference to pre-inserted markers or other pre-existing reference points within the stream as required by Claim 1. Applicants therefore respectfully assert that Dunn *et al.* does not anticipate Claim 1 as currently amended.

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**Rejection of Claim 2 RE: 35 U.S.C. §102(b)**

Claim 2 has been rejected under 35 U.S.C. §102(b) as being anticipated by Kwoh *et al.* (U.S. Patent No. 6,115,057). Applicants respectfully traverse this rejection.

Kwoh *et al.* uses a rating a text decoder 708 to extract the rating data and the text data from the vertical blanking interval. The text that replaces the rated segment is decoded by the rating and text decoder 708 and sent to character generator 714. (Kwoh, col. 17, lines 3-22). Claim 2 requires the insertion of markers indicating a rating of content. As stated in paragraph 47 of the present application, the markers may be inserted by the server system. The markers may indicate a rating content of the stream proximate to the position of the marker. The text decoder 708 of Kwoh is not identifying a rating-indicative marker in the stream, but is reading replacement text. Applicants therefore respectfully assert that Kwoh *et al.* does not anticipate claim 2.

**Rejection of Claims 3-8 RE: 35 U.S.C. §102(e)**

Claims 3-8 and 10-15 are rejected under 35 U.S.C. §102(e) as being anticipated by DePrez *et al.* (U.S. PG Pub. 2003/0188316). Applicants respectfully traverse this rejection.

Claim 3 requires a marker indicating the proximity to advertisements in the at least one stream. DePrez does not indicate proximity to advertisements in at least one stream, but inserts advertisements when authorization is denied, the video program is stopped or paused or when the signal is unavailable. (DePrez, paragraph 0205) There is no indication of a marker indicating proximity to an advertisement in the stream; DePrez inserts an advertisement based on the action of the user or a failure or rejection of the system. DePrez therefore does not anticipate claim 3. For at least these reasons, applicants respectfully request this rejection be withdrawn.

Claim 4 scans for a restricting condition as indicated by a marker inserted in the stream by the server system. DePrez does not scan for restricting conditions, but makes a determination as to whether or not to insert promotional information. (DePrez, paragraph 0092) Promotional information is inserted in DePrez as part of a logic routine that makes

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a determination as to whether the user is authorized to view the club channel (DePrez, Fig. 7), not in response to a particular marker indicating a restricting condition. DePrez therefore does not anticipate claim 4. For at least these reasons, applicants respectfully request this rejection be withdrawn.

Claims 5-8 and 10-15 are dependent on claim 4. For at least the reasons cited above, applicants respectfully request that these rejections be withdrawn.

**Rejection of Claim 9 and 16 RE: 35 U.S.C. §103**

Claims 9 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over DePrez *et al* in view of Kwoh *et al*. Applicants respectfully traverse this rejection.

Claims 9 and 16 are dependent on claim 4. As argued above, promotional information is inserted in DePrez as part of a logic routine that makes a determination as to whether the user is authorized to view the club channel (DePrez, Fig. 7), not in response to a particular marker indicating a restricting condition. It therefore does not anticipate claim 4. The addition of Kwoh *et al*. does not cure this lack. Applicants respectfully request this rejection be withdrawn.

**Other**

Other dependent claims of the present application are distinguished from the cited references at least for the reasons provided for their base claims.

**Conclusion**

In view of the above amendments and remarks, applicant believes that this application is now in condition for allowance. Applicant respectfully requests that a Notice of Allowability be issued covering the pending claims. If the Examiner believes that a telephone interview would in any way advance prosecution of the present application, please contact the undersigned.

Signature      /Charles A. Mirho/

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Charles A. Mirho  
Reg. 41,199  
Attorney for Applicant

Address all correspondence to:

FSP LLC

Attn: Charles A Mirho

P.O. Box 890

Vancouver, WA 98666-0890

USA

Phone: 360-737-1748

Fax: 360-294-6426